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Date May 5, 1999

John P. Parise

(Print Name)

(Signature)

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Binggeli et al.

Group: 1613

Serial No. 08/711,339, filed September 6, 1996

Examiner: R. Ramseur

For: **NOVEL PIPERIDINE DERIVATIVES HAVING RENIN INHIBITING ACTIVITY**

COMMUNICATION

Nutley, New Jersey 07110

May 5, 1999

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Communication is filed in response to the March 8, 1999 Office Action issued in connection with the above-identified patent application. A response to this Office Action is due May 8, 1999.

This application is currently under appeal to the Board of Patent Appeals and Interferences ("Board" – a brief was filed February 22, 1999) and is the subject of a Renewed Petition to Commissioner Under 37 C.F.R. § 1.144 (a petition was filed March 29, 1999).

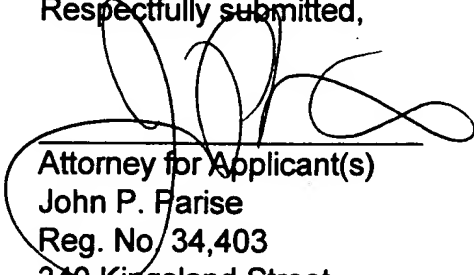
Claims 1-40 and 42-137 are pending in the subject application. Portions of claims 1-17, 20, 32, 33, 35-39, 42-45, 47, 68-72, 74, 77, 87-90, and all of claims 18, 19, 21-31, 34, 46, 48-67, 73, 75, 76, 79-86, and 91-136, have been withdrawn from further consideration under 37 C.F.R. § 1.142(b) because they allegedly are drawn to non-elected inventions. Claims 40, 78, and 137 have been objected to as being dependent upon a non-allowed claim. The Patent Office has not rejected any claim *per se*. However, it is applicants' position that the Patent Office has in fact rejected all of the pending claims as a result of an improper restriction requirement. Future handling of this matter is now under consideration by the Board and the Group Director.

The Office Action states "the petition being denied, applicant should limit the claims to the subject matter indicated as being examined." The obligation of Applicants to amend claims to accomplish such limitation is the basis for the pending appeal and petition. Until the Board and the Group Director make a determination, it is applicants' position that no action is required by applicants.

Applicants have in the past indicated a willingness to consider limiting the application to a subgenus as defined in a pending claim. To this end, applicants would consider limiting the pending application to the subgenus as defined in claim 10, if the Patent Office would examine claim 10 in its entirety on the merits. This subgenus includes the species of claim 137, which was elected in a Communication dated July 16, 1998. Applicants would reserve the right to prosecute a further continuing patent application containing claims the remaining subject matter of the application. If such proposal is not acceptable to the Patent Office, applicants will await the decisions of the Board and the Group Director.

No fee is required in connection with the filing of this Communication. If any fee is deemed necessary, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 08-2525.

Respectfully submitted,



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